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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,071	11/05/2003	Yoshikazu Watanabe	826.1901	6314
21171	7590	02/21/2008		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER JOO, JOSHUA	
			ART UNIT 2154	PAPER NUMBER
			MAIL DATE 02/21/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

AK

Office Action Summary	Application No. 10/701,071	Applicant(s) WATANABE ET AL.	
	Examiner JOSHUA JOO	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Detailed Action

1. This Office action is in response to communication dated 11/26/2007.

Claims 1-10 are presented for examination.

Response to Arguments

2. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

3. Claims 2, 4, 7, and 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 6-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant is seeking to patent a terminal comprising only of units, and a unit is defined in the art as a software element (IEEE 100: The authoritative Dictionary of IEEE Standard Terms, Seventh Edition, 2000). The claimed invention is directed only to software, and units, i.e. software, do not meet one of the four categories of invention and is not statutory. Specifically software is not a series of steps or acts and thus is not a process. Software is not a physical article or object and as such is not a machine or manufacture. Software is not a combination of substances and therefore not a composition of matter.

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Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-4, 6-7, 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i) Regarding claims 2 and 10, the claims recite, "making the user release the protection..." It is unclear as to how a user, i.e. person, is made to perform an action since the actions of a user cannot be physically controlled. Furthermore, "the determination" lacks sufficient antecedent basis.

ii) Regarding claims 3 and 9, the claim recites, "making the user release the protection if the protection of the plurality of electronic mails is released". Firstly, it is unclear as to how a user, i.e. person, is made to perform an action since the actions of a user cannot be physically controlled.

Secondly, if the protection of the plurality of electronic mails is released as recited in the claim, it is unclear as to why or how the user releases the protection of the plurality of electronic mails. It would appear redundant for the user to release the protection if the protection is released. Does Applicant intend for the claim to recite, "if the protection of the plurality of electronic mails is to be released"?

iii) Regarding claim 6, the claimed communications terminal comprises only of units. A unit is defined in the art as a software element. Therefore, the scope of the invention is not clear, and it is unclear as to whether Applicant intends the claimed terminal to be a physical apparatus or intends only software elements of the terminal.

iv) Regarding claim 7, the claim recites, "makes the user release the protection..." It is unclear as to how a user, i.e. person, is made to perform an action since the actions of a user cannot be physically controlled. Furthermore, "the determination" lacks sufficient antecedent basis.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 3, 5-6, 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Dorenbosch et al. US Patent #6,420,960 (Dorenbosch hereinafter).

10. As per claims 1 and 8, Dorenbosch teaches the invention as claimed including an electronic mail receiving method and computer readable storage medium for use in a communications terminal having an electronic mail reception function, comprising:

making to a user a notification that protection must be released if a state where a new electronic mail cannot be captured unless the protection of an existing electronic mail is released is determined, when the new electronic mail is received, or an inquiry is made to a mail server (col. 2, lines 58-60. Option to lock or set priority for messages. col. 5, lines 47-51; col. 6, lines 1-6, 55-58. Alert user to purge messages to free memory for messages after considering lower priority messages. Purging includes releasing protection, and based on the alert, a user is implied to remove higher priority or locked messages since space for lower priority messages are already considered.).

11. As per claim 6, Dorenbosch teaches the invention as claimed including a communications terminal, comprising:

a determining unit determining a state where a new electronic mail cannot be captured unless protection of an existing electronic mail is released, when the new electronic mail is received, or an inquiry is made to a mail server (col. 5, lines 47-51; col. 6, lines 1-4. Determine that there is insufficient memory space to store message(s) based on available memory space from lower priority messages.); and

a guidance unit making to a user a notification that the protection must be released, if said determining unit determines the state where the new electronic mail cannot be captured unless the

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protection of an existing electronic mail is released (col. 5, lines 47-51; col. 6, lines 1-6, 55-58. Alert user to purge messages to free memory for messages. Purging includes releasing protection, and based on the alert, a user is implied to remove higher priority or locked messages since space for lower priority messages are already considered.).

12. As per claims 3 and 9, Dorenbosch teaches the electronic mail receiving method according to claim 1, further comprising making the user release the protection by transferring display contents to a protection release operation screen after making the notification to the user (col. 5, lines 47-51; col. 6, lines 1-6, 55-58. Alert user to purge message. col. 2, lines 56-60. User interface comprising display provides options to delete, lock, and select priority. It is inherent that the device presents a screen such that the user can make actions to purge including deleting, selecting priority.).

13. As per claim 5, Dorenbosch teaches the electronic mail receiving method according to claim 1, wherein the state where a new electronic mail cannot be captured unless the protection of an existing electronic mail is released is a state where a received electronic mail box is full and all of existing electronic mails are set to be protected (col. 5, lines 48-51. Determine that message cannot be stored if amount of memory freed from lower priority messages is not sufficient.).

Conclusion

14. A shortened statutory period for reply to this Office action is set to expire **THREE MONTHS** from the mailing date of this action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Thursday 8AM to 5PM and every other Friday.

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16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

NATHAN FLYNN
SUPERVISORY PATENT EXAMINER

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J.J./

Examiner, Art Unit 2154